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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,258	03/18/2004	Thomas Weyh	GK-ZEI-3049D/500343.20242	7479
26418	7590	05/09/2006	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650				ROBINSON, MARK A
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/804,258	WEYH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark A. Robinson	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 March 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) 1-8, 10 and 11 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

Art Unit: 2872

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/23/06 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon (US 5192980) in view of Stafford (US 5504575).

Art Unit: 2872

Dixon shows a laser scanning microscope including a microscope unit (e.g. fig. 5) and a scanning module (e.g. 514,520) and also shows a detection arrangement which detects different wavelengths (see fig. 9), but does not teach the detection arrangement to include a dispersive element in a detection beam path dispersing light from an object, a micromirror arrangement switching selected wavelengths, and a detector that receives the switched wavelengths. However, this type of detection arrangement is shown by Stafford as discussed previously who shows dispersive element(44) in a detection beam path dispersing light from an object, a micromirror arrangement(46) switching selected wavelengths, and a detector(50) that receives the switched wavelengths. Further, Stafford's micro-mirror arrangement is provided so that they (the mirrors) "can be switched between only two positions" as taught in fig. 1, col. 4 lines 26-27 and in the patent U.S. 5,061,049 referenced by Stafford (this disclosed device operates in a bistable or on-off mode, thus implying switching between only two positions). It would have been obvious to the ordinarily skilled artisan at the time of invention to use Stafford's detection arrangement with Dixon's microscope in order to enable detection or measurement of the individual

Art Unit: 2872

wavelengths emitted from the object under study as taught by Stafford.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grober (US 5473157) in view of Stafford (US 5504575).

Grober shows a laser scanning microscope including a microscope unit (e.g. fig. 5) and a scanning module (e.g. col. 1 line 8) and also shows a detection arrangement which detects dispersed wavelengths (450,460), but does not teach the detection arrangement to explicitly include a dispersive element in a detection beam path dispersing light from an object, a micromirror arrangement switching selected wavelengths, and a detector that receives the switched wavelengths. However, this type of detection arrangement is shown by Stafford as discussed previously who shows dispersive element(44) in a detection beam path dispersing light from an object, a micromirror arrangement(46) switching selected wavelengths, and a detector(50) that receives the switched wavelengths. Further, Stafford's micro-mirror arrangement is provided so that they (the mirrors) "can be switched between only two positions" as taught in fig. 1, col. 4 lines 26-27 and in the patent U.S. 5,061,049 referenced by Stafford (this disclosed device operates

Art Unit: 2872

in a bistable or on-off mode, thus implying switching between only two positions). It would have been obvious to the ordinarily skilled artisan at the time of invention to use Stafford's detection arrangement with Grober's microscope in order to enable detection or measurement of the individual wavelengths emitted from the object under study as taught by Stafford.

***Response to Arguments***

5. Applicant's arguments filed 3/23/06 have been fully considered but they are not persuasive.

Applicant has argued that Stafford does not disclose the micro-mirror arrangement switchable between only two positions as claimed.

However, Stafford does indeed disclose this limitation as set forth above in the rejections.

It should further be noted that the claim specifically recites "the micro-mirror arrangement is provided so they can be switched between only two positions." The deflection of a micro-mirror or an individual element thereof is dependent on the applied control signal (e.g. voltage). Thus, the limitations added to the claim are met by the reference, regardless of any explicit teaching thereby, since Stafford's

Art Unit: 2872

micro-mirror arrangement could be or has the ability to be (i.e. "can be") switched between only two positions if the control signal is supplied accordingly.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bloom discloses a microscope including a micro-mirror arrangement switchable between only two positions.

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

Art Unit: 2872

is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Application/Control Number: 10/804,258

Page 8

Art Unit: 2872

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access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).

MR

5/5/06

  
MARK A. ROBINSON  
PRIMARY EXAMINER